

REMARKS/ARGUMENTS

Claims 1-34 will be pending and under consideration upon entry of the above-made amendments. Claims 1 and 21 have been amended to clarify that which Applicants regard as the invention. New claims 29-34 have been added. The amended claims and new claims are fully supported by the specification as indicated below. No new matter has been added.

Claims 1 and 21 are amended to remove the phrase “which is higher than about 90 °C” and to now recite only that the decorated vitreous article is subjected to an elevated temperature after being radiation cured in order to cure and fuse the ink to the glass substrate.

Claim 21 is further amended to clarify that it is the ink composition and not the decorated vitreous article which contains free acid groups and which possesses the characteristics (i) and (ii), and to correct a typographical error in the spelling of the term “indicia.” Claim 21 is also amended to clarify that the term “comprising” at line 6 of the claim refers to the method and not to the subject matter of romanet (ii), which describes a property of the ink composition.

Support for presently amended claims 1 and 21 is found in the specification, for example, at page 18, lines 3-5.

Support for new claims 29-34 are found in the specification, for example, at page 18, lines 6-7.

I. The Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1-28 stand rejected under 35 U.S.C. §112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states that the phrase “higher than about 90 °C” as recited in claims 1 and 21, allegedly lacks written description support in the application as originally filed.

Applicants wish to remind the Examiner that the test for sufficiency of written description is whether the disclosure of the application ‘reasonably conveys to the artisan that the inventor had possession’ of the claimed subject matter. In re Kaslow, 707 F.2d 1366, 1375, 217 U.S.P.Q. (BNA) 1089, 1096 (Fed. Cir. 1983); accord Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563; *see also*, Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575,

227 U.S.P.Q. (BNA) 177, 179 (Fed. Cir. 1985). It is clear that the specification need not provide written description support in exactly the same words that are used in the claims. It is enough that the description conveys to the skilled artisan that the applicant had possession of the invention. For example, see In re Wilder, 736 F.2d 1516, 1520, 222 U.S.P.Q. 369, 372 (Fed. Cir. 1984):

It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant has invented the subject matter later claimed.

See also Application of Lukach, 442 F.2d 967, 969, 169 U.S.P.Q. 795, 796 (C.C.P.A. 1971): “[T]he invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of 112.” It is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that applicants invented the processes including those limitations. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Indeed, not only is unnecessary to described the claimed invention *ipsis verbis* to satisfy the written description requirement of 35 U.S.C. § 112, but, where a non-essential feature of the claim is concerned, the claim need not be limited to an embodiment exemplified in the specification if one of ordinary skill in the art will recognize that applicants invented the claimed subject matter. *See In re Peters*, 723 F.2d 891 (Fed. Cir. 1983).

As such, Applicants direct the Examiner’s attention to presently amended Claims 1 and 21 in which the allegedly unsupported phrase “higher than about 90 °C” has been deleted, and which now recite instead that the decorated vitreous article is subjected to an “elevated temperature” after the radiation curing process has taken place. Support for the present amendments are found, for example, in the instant specification at page 18, lines 3-5: “In some cases it may be necessary to subject the newly screened glass container to a slightly elevated temperature prior to UV curing the applied ink on the substrate, or to an additional *post-UV cure application of heat* to finally polymerize the ink on the substrate.” Applicants contend that it would be obvious to one of ordinary skill in the relevant art that the range of temperatures to which the ink may be exposed to, subsequent to UV curing, in order to finally polymerize on the substrate is neither infinite nor overly broad so as to require undue experimentation to determine. It would be well within the abilities of the skilled artisan to be able to apply and monitor such a post-UV cure application of heat in order to determine a useful temperature range and time of exposure to heat that would be sufficient to fully bond

the ink to the vitreous article. Further, the skilled artisan would certainly realize that exposure of the decorated vitreous article to *very high* temperatures after UV-curing could be detrimental and possibly destructive to the cured ink that is present on the decorated article. The approximate temperature that would be damaging to the post-UV cured ink would be somewhat intuitive to one of ordinary skill in the relevant art and as such, a finite and almost universally recognized upper limit on the “elevated temperature” as recited in presently pending claims 1 and 21 need not be provided in the instant claims or specification in order to meet the written description requirement. With regard to the temperature and time ranges provided in the instant specification in connection with a post-UV cure application of heat, Applicants point out that the temperature and time ranges provided at page 18, lines 6-7 of the specification clearly relate to *preferred embodiments* of the present invention for the temperatures and time periods that may be utilized during such a post-UV cure exposure to heat. As stated: “*Preferably*, the decorated substrate is subjected to post-UV cure heating at a temperature of 90 to 200 °C, *preferably* 100-200 °C for a period of 0.5 to 30 minutes.” This language clearly indicates that these temperature and time ranges are not to be construed as limiting embodiments, and as such, Applicants believe that the term “elevated temperature” as recited in currently pending claims 1 and 21 meets the written description requirement as it is: (a) supported in the specification, not verbatim, but rather implicitly at page 18, lines 3-5: “In some cases it may be necessary to subject the newly screened glass container to . . . an additional post-UV cure application of heat to finally polymerize the ink on the substrate;” and (b) described in the specification in a way that clearly conveys to the skilled artisan that the applicant had possession of the claimed invention.

Thus, in view of the present amendments, Applicants respectfully submit that the rejection of claims 1-28 under 35 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

II. The Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-28 stand rejected under 35 U.S.C. §112, second paragraph as being allegedly indefinite.

Specifically, the Examiner alleges that the scope of claim 1 is confusing because of the use of the term “sufficiently,” which the Examiner feels is unclear, in the phrase “the ink is sufficiently adhered to the vitreous article” as recited in claim 1. Claim 1 is presently amended to remove the phrase “sufficiently adhered” and replace it with the phrase “cured and fused.”

The Examiner also contends that scope of claims 1 and 21 is allegedly confusing because of the recitation of the phrase "higher than about 90 °C" to describe the scope of the elevated temperature to which the decorated vitreous article is subjected to. Claims 1 and 21 are presently amended to delete the allegedly indefinite phrase "higher than about 90 °C" and to instead recite that the decorated vitreous article is subjected to an "elevated temperature."

Thus, in view of the present amendments, Applicants respectfully submit that the rejection of claims 1-28 under 35 U.S.C. § 112, second paragraph, has been overcome and should be withdrawn.

CONCLUSION

Applicants respectfully request consideration and entry of the foregoing amendments and remarks into the file history of the subject application. Withdrawal of all outstanding rejections and an early allowance are earnestly sought. No fee is believed due, however in the case that a fee is due, please charge any required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150. The Examiner is invited to call the undersigned with any questions concerning the foregoing.

Date July 28, 2003

Respectfully submitted,
By: *Jeffrey P. Berigan Reg. No. 35,203*
Anthony M. Insogna *51,467* (Reg. No.)

PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(212) 790-9090